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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kuriacose Joseph

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

09/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/903,457

Applicant(s)

JOSEPH ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 165-185, 218-236, 247, 250 and 252 is/are pending in the application.
- 4a) Of the above claim(s) 168-184, 221-235, 247 and 250 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 165-167, 185, 218-220, 236 and 252 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of group II including claims 165-185, 218-236, 247, 250, 252 and 254 in the reply filed on 8/9/2007 is acknowledged.

The applicant was further required to elect a single disclosed species (see earlier office action, pages 7-8, mailed on 7/6/2007). During a telephone conversation with attorney Elena B. Dreszer on 9/10/2007 an election of species 1 was made without traverse to prosecute the invention of Group II, claims 165-167, 185, 218-220, 236, 252 and 254. Non elected claims 168-184, 221-235, 247, 250 are withdrawn. Applicant has canceled claims 1-164, 186-217, 237-246, 248-249, 251 and 253-255. Currently claims 165-167, 185, 218-220, 236, 252 are pending for examination in the instant application.

### *Claim Rejections - 35 USC § 251*

2. Claims 165-167, 185, 218-220, 236, 252 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control

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resulting in appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.

The independent claims 165, 218 and 252, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item.

The applicant's attention is also invited to MPEP 2163.05 Changes to the Scope of Claims [R-2], " **The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the**

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terminology used in the original disclosure. **To comply with the written description requirement of 35 U.S.C. 112, para. 1**, or to be entitled to an earlier priority date or filing date under 35 U.S.C. **119, 120, or 365(c)**, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § **2163** for examination guidelines pertaining to the written description requirement.

#### **I. BROADENING CLAIM**

##### **Omission of a Limitation**

**A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) .....**

.....

In the present case, the claims as recited omit essential elements/critical features of the invention as explained above and therefore do not comply with the written description requirement .

Since dependent claims 166-167, 185, 219-220 and 236 inherit the deficiencies of their independent claims they are also rejected for the same reason as set forth above.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3.1. Claims 165-167, 185, 218-220, 236 and 252 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.

All the independent claims 165, 218 and 252, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server

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environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item.

The applicant's attention is also invited to MPEP 2163.05 Changes to the Scope of Claims [R-2], " The failure to meet the written description requirement of **35 U.S.C. 112**, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of 35 U.S.C. **112**, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. **119**, **120**, or **365(c)**, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § **2163** for examination guidelines pertaining to the written description requirement.

#### **I. BROADENING CLAIM**

##### **Omission of a Limitation**

A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) ..... “.

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In the present case, the claims as recited omit essential elements/critical features of the invention as explained above and therefore do not comply with the written description requirement.

Since dependent claims 166-167, 185, 219-220 and 236 inherit the deficiencies of their independent claims they are also rejected for the same reason as set forth above.

3.2. Claims 165-167, 185, 218-220, 236 and 252 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored in a **permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.



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All the independent claims 165, 218 and 252, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item. Therefore, the claims as recited contain subject matter, that is storing the personal information in a memory external to client, in an open server environment which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since dependent claims 166-167, 185, 219-220 and 236 inherit the deficiencies of their independent claims they are also rejected for the same reason as set forth above.

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3.3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 165-167, 185, 218-220, 236 and 252 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 165-167, 185, 218-220, 236 and 252 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements/steps/ essential structural cooperative relationships of elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer. The claims, as recited, do not include the above critical features.

4. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

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limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 165-167, 185, 218-220, 236 and 252 are rejected under 35 U.S.C. 102(e) as being anticipated by Pat. No. 5,621,456, Florin et al (hereinafter Florin).

Regarding claim 165, Florin discloses a method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method comprising (i.e. home shopping interface)(see Fig. 1, and col. 23, line 59 - col. 24, line 7):

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receiving an order request at a client system, automatically determining an item identity for an item to which the order request pertains, automatically retrieving personal information previously stored the retrieved personal information pertaining to a user associated with the client system and causing an order to be placed, the order including the item identity and the retrieved personal information (see col.24, lines 7-58 and Figs. 45-50 discloses receiving an order request via icon 409 at a client system, automatically determining an item identity for an item , such as " Lucks Mini Espresso" to with the order request pertains and causing an order to be placed[see figs 49-50] including the item identity and the retrieved personal information relating to the PIN entered in Fig.49. The inputting of PIN causes automatically retrieving personal information previously stored the retrieved personal information pertaining to a user associated with the client system for making payments, see col.12, line 63-col.13, line 6 and col.22, lines 32-41)

Regarding claim 166, Florin teaches that the order request is received at the client system through detection of an order action by the user utilizing the client system (see figs. 49 & 50 where the user uses order icon on the client system which triggers placement of order).

Regarding claim 167, Florin teaches that the order action is performed during the showing and/or describing of the item via the client system (i.e. full motion video display of various paid for commercials or advertising messages)(see Fig. 44-50 and col. 23, line 67 - col. 24, line 7);

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Regarding claim 185, florin teaches receiving, at the client system from a server system , an order confirmation (see at least Fig.50).

Regarding claims 218-220, 236 and 252, their limitations are closely parallel to the limitations of claims 165-167 and 185 and therefore they are analyzed and rejected on the basis of same rationale as set forth for claims 165-167 and 185 above.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Schlafly (US Patent 4,734,858) discloses ordering an item via a communication network by a single action with the client (i.e. once the item has been specified, it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent by automatic dialing of the local processing center ...)(see at least Abstract, col.1, lines 44-57 and col. 7, lines 35-46). In addition, Schlafly discloses wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed (i.e. user ID number is then stored in the send memory)(col. 9, lines 12

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21) and 2) the item finder to enable the client to identify the item as currently being offered for sale at the time of the single action (i.e. order information including the item code)(col. 9, line 52 - col. 10, line 10).


(ii) Zachary et al., "Technology: HP is building Gadget to Make TVS Interactive" (hereinafter Zachary) discloses an interactive TV system including a TV control box and a remote controller so that a home user can shop (see abstract and page 1). While shopping on the interactive TV system, a user can press the remote controller to place an order for a product (see abstract and page 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
9/13/2007

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/10/01, 8/15/01, 3/26/02, 5/9/02, 9/30/02, 12/10/04, 6/14/04 &6/15/2007.